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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/762,695

01/22/2004

Jorge L. Orbay

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03/16/2007

GORDON & JACOBSON, P.C.

60 LONG RIDGE ROAD

SUITE 407

STAMFORD, CT 06902

EXAMINER

ISABELLA, DAVID J

ART UNIT

PAPER NUMBER

3738

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/762,695

Applicant(s)

ORBAY, JORGE L.

Examiner

DAVID J. ISABELLA

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 9, 10, 12, 14-18, 28, 29, 31-35, 37, 39-42, 44-50, 52 and 53 is/are pending in the application.
- 4a) Of the above claim(s) 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-1-3, 9, 10, 12, 14-18, 28, 29, 31-35, 37, 39, 40, 42, 44-50, 52 and 53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of the Claims

Currently claims 1-3,9,10,12,14-18,28,29,31-35,37,39-42,44-50, 52 and 53 are pending for action.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 9,10,12,14-18,28,29,31-35,37,39,40,42,44-50,52,53 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6358250 and/or 6767351. Although the conflicting claims are not identical, they are not patentably distinct from each other because the earlier

patent discloses the device and the claims in the instant application are species of the claims of the patent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9,10,12,14-18,28,29,31-35,37,40,42,44-50,52,53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halloran [3489143 in view of any of Calderale [EP 0382256], Bono [5954722], Talos et al [5709686] and Frigg et al [6206881].

Halloran discloses an orthopedic fixation system, comprising: a) a rigid device having an upper surface and a lower surface, said device having a head portion angled with respect to a shaft portion; and b) a plurality of elements for supporting the bone extending from said lower surface of said head portion.

While Halloran is not specific to the supporting elements, it appears from the drawings that the elements are obliquely angled relative to each other and none of said elements converging in angle toward another element. If not inherent in Halloran, Bono teaches supporting elements that are capable of being oriented at a plurality of angles and fixed at the final desired angle. As such, the threaded bore of Bono may be applied to the fixation device of Halloran to better accommodate proper fixation of the device with respect to the fractured bone. The use of threaded holes in combination with

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fastening elements to provide for better securement of the bone device to the bone is taught by each of Bono, Talos et al and Frigg et al. To provide the holes with threads to cooperate with threaded elements of Halloran thereby forming a more secure fastening system would have been obvious from the teachings of any of the secondary references.

Claim 10, see hole in shaft portion of Halloran.

Claim 12, see smooth curve arrangement in the head portion of Halloran.

Claim 14, if not inherent in Halloran, see Halloran as modified by the secondary references supra.

Claim 15, while Halloran discloses three holes, examiner contends Halloran is not limited to the illustrated device. The numbers of holes for receipt of a supporting element could exceed three depending on the in vivo requirements of the patient. As such it would have been obvious to one with ordinary skill in the art to form a device with more than the illustrated three holed device as shown by Halloran without departing from the spirit of the invention. Adding one, two or more additional holes would serve to further stabilize the device to the bone.

Claims 16-18, see rejections supra.

Claim 28, see rejection to claim 15 supra.

Claim 29, the axes of the holes would inherently "follow" the contour of the subchondral bone. Note, the term "follow" does not necessarily have the same meaning as "aligned".

Claim 31, see rejection to claim 9 supra.

Claim 32, the device of Halloran is capable of being placed at a distal radius bone.

Claims 33-35, see corresponding rejections supra.

Claim 37, see rejection to claim 9 supra.

Claim 40, see medial lateral arrangement of the holes.

Claim 42, see rejection to claim 29 supra.

Claim 44-50, 52 and 53, see rejections to the corresponding claims supra.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowery et al [5364399] in view of any of Bono [5954722], Talos et al [5709686] and Frigg et al [6206881]

Lowery et al discloses an orthopedic fixation system, comprising: a) a rigid device having an upper surface and a lower surface, said device having a head portion and a shaft portion; and b) a plurality of elements for supporting the bone extending from said lower surface of said head portion, said elements being obliquely angled relative to each other and none of said elements converging in angle toward another element. The use of threaded holes in combination with fastening elements to provide for better securement of the bone device to the bone is taught by each of Bono, Talos et al and Frigg et al. To provide the holes with threads to cooperate with threaded elements of Lowery et al thereby forming a more secure fastening system would have been obvious from the teachings of any of the secondary references. Note, the recitation of "angled upward" does not mean non-coplanar or out of plane.

Claim 2 and 3 see figure 5 and corresponding portion of the specification.

Conclusion

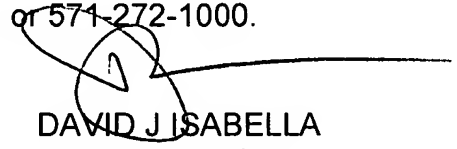
Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J. ISABELLA whose telephone number is 571-272-4749. The examiner can normally be reached on MONDAY-FRIDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CORRINE MCDERMOTT can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DAVID J ISABELLA
Primary Examiner
Art Unit 3738

DJI
3/13/2007